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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/747,878	12/29/2003	Seiji Tanaka	81752.0151	2800
26021	7590	04/06/2005	EXAMINER	
HOGAN & HARTSON L.L.P. 500 S. GRAND AVENUE SUITE 1900 LOS ANGELES, CA 90071-2611			NOLAN JR, CHARLES H	
			ART UNIT	PAPER NUMBER
			2854	

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/747,878

Applicant(s)

TANAKA ET AL.

Examiner

Charles H. Nolan, Jr.

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/29/03; 6/14/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-2,4,6,11,27 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by computer translation of JP 08-282068, hereafter "'068."

The page numbers referred to hereinbelow in reference to the '068 patent are the Examiner's handwritten numbers on the bottom of each page. With respect to Claim 1, '068 teaches the connection interface 11 on the front page diagram, the connection object detection means (connection decision means) on page 5, paragraph [0010], the mode setting means function on page 5, paragraphs [0010]-[0011], the demonstration printing means (printing sample) on page 5, paragraph [0010] and the recitation after "wherein" on page 5, paragraphs [0010]-[0012] and in the Constitution of the Abstract. With respect to Claims 2,6, '068 teaches that the connection object is detected when

Art Unit: 2854

power is supplied in the Constitution of the Abstract, lines 1-2. With respect to Claim 4, '068 teaches that the connection object is detected when it is connected in Constitution of the Abstract, lines 10-12. With respect to Claim 11, it is noted that the printer of '068 is capable of printing on print medium including write once optical disks. With respect to Claim 27, '068 teaches that mode setting means continues to set the print mode to the demonstration mode until the power is turned off on page 4, paragraphs [0008]-[0009] and page 6, paragraph [0028].

4. Claims 1,3 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Hooper et al. (6,761,493).

With respect to Claim 1, Hooper teaches the connection interface 99 on the front page diagram, the connection object detection means function in figure 3 @ 304, the mode setting means function in the Abstract, lines 5-7 and the functional language recited after "wherein" in the Abstract, lines 1-12. With respect to Claim 3, Hooper teaches that the connection object is detected when print medium is loaded in figure 4 @ 414 and figure 5 @ 415-416B.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15. **An unavoidably necessary part of the next response to this Office Action is a sworn English translation of the foreign priority papers.**

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 12-13,15,17-18,23,28 are rejected under 35 U.S.C. 103(a) as being unpatentable over computer translation of '068 in view of Walker et al. (6,557,965).

With respect to Claim 12, '068 teaches the mode setting means on page 5, paragraphs [0010]-[0011], the demonstration printing means on page 5, paragraph [0010]. '068 teaches all the claim limitations except for the print medium detection means. Walker teaches the print medium detection means in figures 8 and 20-23. It would have obvious to one of ordinary skill in the art to incorporate the print medium detection means of Walker into the invention of '068 "so the printing mechanism can automatically adjust printing for optimal images without requiring user intervention and without damaging the media or finished image" as taught by Walker in column 3, lines 39-42. With respect to Claim 15, '068 teaches that the user interface is eliminated and that only the "FF key 8b" is required to be pressed in the Constitution of the Abstract, lines 7-8. With respect to Claim 17, '068 teaches the print start key 8b in the Constitution of the Abstract, lines 8-9. With respect to Claim 18, '068 teaches the specific operation includes an operation of supplying power key 8 in the Constitution of the Abstract, line 1-2. With respect to Claim 23, '068 teaches the connection interface 11 on the front page diagram, the connection object detection means (connection decision means) on page 5, paragraph [0010] and the recitation after "wherein" on page 5, paragraph [0011]. With respect to

Claim 28, '068 teaches that mode setting means continues to set the print mode to the demonstration mode until the power is turned off on page 4, paragraphs [0008]-[0009] and page 6, paragraph [0028].

***Allowable Subject Matter***

7. Claims 5,7-10,14,16,19-22,24-26,29-30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

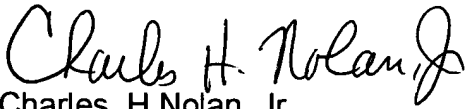
8. The following is a statement of reasons for the indication of allowable subject matter: The Examiner reserves comment until the entire instant application is in condition for allowance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles H. Nolan, Jr. whose telephone number is 571-272-2171. The examiner can normally be reached on Monday through Thursday 8:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on 571-272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2854

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Charles H Nolan, Jr.  
Primary Examiner  
Art Unit 2854

CHN